

REMARKS

Claims 1, 2, 4 – 10 and 12 - 20 are pending in the present application. Claims 3 and 11 were previously canceled. Claim 20 is newly added.

In section 4 of the Office Action, claims 1, 2, 4 – 10 and 12 – 19 are rejected under 35 U.S.C. 112, second paragraph, on the basis that the use of the term "configurable", as recited in claims 1, 10 and 15 - 17, renders the claims indefinite. Applicant amended claims 1, 10 and 15 - 17 as suggested by the Examiner. Withdrawal of the objection is respectfully solicited.

Also in section 4 of the Office Action, claims 1, 2, 4 – 10 and 12 – 16 are rejected under 35 U.S.C. 112, second paragraph, on the basis that the use of the phrase "a program for testing said second DUT core", as recited in claims 1, 10, 15 and 16, renders the claims indefinite. Applicant determined that the phrase is not necessary for patentability of claims 1, 10, 15 and 16, and so, Applicant deleted the phrase from claims 1, 10, 15 and 16. Withdrawal of the objection is respectfully solicited.

In section 5 of the Office Action, claims 1, 2, 4 – 10 and 12 - 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,461,310 to Cheung et al. (hereinafter "the Cheung et al. patent"). This set of claims contains five independent claims, namely claims 1, 10 and 15 - 17. Applicant amended claims 1, 10 and 15 - 17 to clarify a feature of these claims that is neither described nor suggested by the Cheung et al. patent.

Claim 1 provides for an automated test equipment (ATE). A device under test (DUT) is defined as (a) a first DUT core that represents a first functional unit of the DUT and (b) a second DUT core that represents a second functional unit of the DUT. The ATE includes, *inter alia*, a programming component that obtains a specification for testing the first DUT core, prepares a program based on the specification, and programs an ATE-port with the program.

The Cheung et al. patent is directed toward an ATE system. Test data is loaded into an individual pin slice circuit as a vertical word such that all of the bits of the vertical word correspond to the individual pin, thus, allowing characteristics of an individual pin test sequence to be varied independently of other pins (Abstract). FIG. 1 of the Cheung et al. patent is an illustration of the ATE situated between a workstation 12 and a device under test (DUT) 14 (col. 3, lines 19 – 22). Data from a test program is loaded into the ATE from workstation 12 through a VME to Tester Interface 16 (col. 3, lines 28 – 29).

Applicant has not found that the Cheung et al. patent provides a description of preparation of the test program from workstation 12, much less of a component that **prepares the test program based on a specification for testing a DUT core within DUT 14**. Applicant therefore submits that the Cheung et al. patent neither describes nor suggests a programming component that **obtains a specification for testing the first DUT core, prepares a program based on the specification, and programs an ATE-port with the program, as recited in claim 1**. Accordingly, Applicant submits that the Cheung et al. patent does not anticipate claim 1.

Independent claims 10 and 15 – 17 each include a recital similar to that of claim 1, as described above. Accordingly, Applicant also submits that the Cheung et al. patent does not anticipate any of claims 10 or 15 – 17.

Claims 2 and 4 – 9 depend from claim 1, claims 12 – 14 depend from claim 10, and claims 18 and 19 depend from claim 17. By virtue of this dependence, claims 2, 4 – 9, 12 – 14, 18 and 19 are also novel over the Cheung et al. patent.

Applicant respectfully requests reconsideration and withdrawal of the section 102(b) rejection of claims 1, 2, 4 – 10 and 12 – 19.

Applicant amended independent claims 1, 10 and 15 - 17 to clarify a feature of the independent claims that is neither described nor suggested by the art of record, and to

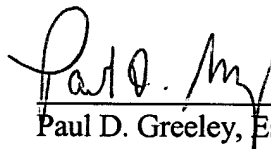
address issues under 35 U.S.C. 112. Applicant also amended all of the claims for one or more of (a) improving form, (b) providing consistent terminology, or (c) avoiding terminology that does not appear to be necessary for patentability. None of the amendments is intended to narrow the meaning of any term of the claims, and as such, the doctrine of equivalents should be available for all of the elements of all of the claims.

Applicant added claim 20 to even further provide the claim coverage that Applicant appears to deserve based on the prior art that was cited by the Examiner. A favorable consideration that also results in the allowance of claim 20 is earnestly solicited.

In view of the foregoing, Applicant respectfully submits that all claims presented in this application patentably distinguish over the prior art. Accordingly, Applicant respectfully requests favorable consideration and that this application be passed to allowance.

Respectfully submitted,

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